

## **REMARKS**

*Please note that the claim amendments provided above consist solely of incorporating existing limitations of dependent claims into parent claims, further defining the scope of claimed elements, and correcting incorrect claim grammar as noted by the Examiner. Consequently, no new matter has been added, and no new search is required. In addition, the amendment to the specification has been provided to correct an obvious grammatical error noted by the Examiner. These amendments are fully supported by the existing specification and do not result in the introduction of new matter to the specification.*

This application is believed to be in condition for allowance because the claims, as amended, are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasonings for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject patent application.

### **1.0 Objection to the Specification:**

In the Office Action of October 22, 2002, the specification was objected to as containing the phrase "is can be." The Applicants have made the appropriate correction as suggested by the Examiner. Consequently, the Applicants respectfully request that the objection to the specification be withdrawn.

### **2.0 Claim Objections:**

In the Office Action of October 22, 2002, claim 42 was objected to as including containing an informality. In particular, the claim as originally written inadvertently included the word "via" in the first line of the claim. As suggested by the Examiner, the claim has been amended to remove the word "via" in the first line of the claim.

Consequently, the Applicants respectfully request that the objection to claim 42 be withdrawn.

### 3.0 Rejections Under 35 U.S.C. §102(b):

In the Office Action of October 22, 2002, claims 1-10, 12-16, 21-22, 26-37, 39-42, and 45-53 were rejected under 35 U.S.C. §102(b), as being anticipated by Novell GroupWise 5.5 as shown by "GroupWise User's Guide for Windows 95/98/NT," (hereinafter "**GroupWise**"). A rejection under 35 U.S.C. §102(b) requires that the Applicant's invention was described in a printed publication more than one year prior to the date of application for patent in the United States. To establish that a patent describes the Applicant's invention, all of the claimed elements of an Applicant's invention must be considered, especially where they are missing from the prior art. If a claimed element is not taught in the referenced patent, then a rejection under 35 U.S.C. §102(b) is not proper, as the Applicants' invention can be shown to be patentably distinct from the cited reference.

### 3.1 Rejection of Claim 1:

The Office Action rejected independent claims 1 and 21 under 35 U.S.C. §102(b) based on the rationale that the **GroupWise** reference discloses each of the elements of the Applicants claimed "...electronic contact resolution method..." However, the Applicants have amended claim 1 to overcome this rejection.

In particular, claim 1 has been amended to incorporate the limitations originally suggested by claim 4. Specifically, claim 1, as amended now recites "automatically **weighting** each entry in the list" and "automatically resolving contact entries in real time by dynamically providing specific contact entries from the maintained list **based on the weight of each entry in the list**" (emphasis added). Note that with respect to the rejection of claim 4, the Office Action suggested that the **GroupWis** reference "teaches entries of the maintained list being weighted...by alphabetical order, the entries closest

to the front of the alphabet are displayed first, and those near the end are displayed at the end.”

However, in stark contrast to the position advanced by the Office Action, the Applicants respectfully suggest that the purely alphabetical sort of entries described by the **GroupWise** reference is **not** a weighting of the entries. In fact, *Webster's Encyclopedic Unabridged Dictionary of the English Language*, Copyright 1996, Random House Value Publishing, Inc., (hereinafter “**Webster's**”) defines the term “alphabetic” as “in the order of the letters of the alphabet.” Similarly, **Webster's** defines “alphabetize” as “to put or arrange in alphabetical order.” In contrast, **Webster's** defines “weight” in the sense offered and described by the Applicants as “a measure of the relative importance of an item in a statistical population.” It should be clear that a simple alphabetical sort, from A to Z as offered by the **GroupWise** reference does not reflect the relative weight or importance of any particular entry. Rather, the **GroupWise** alphabetical sort is merely a convenient and conventional arrangement for sorting entries.

Further, with respect to the rejection of claims 5 and 37, see paragraph 6 of the Office Action, the Office Action suggests that the **GroupWise** reference teaches the weight of an entry being updated dynamically based on the number of times that the entry has been used. The **GroupWise** reference does appear to provide the capability to track the number of times that an entry is used for the purpose of including the entry in a contact list once the entry has been used a preset number of times. However, this capability is in no way a weighting of the entry. In fact, once the minimum number has been reached for the purpose of adding a contact, the **GroupWise** reference does not appear to treat an entry that has been used a thousand times any differently from an entry that has been used three times. Thus, the Applicants strongly disagree with the suggestion that this feature of the **GroupWise** reference is in fact a “weighting” of contact entries as described and claimed by the Applicants.

In addition, with respect to the rejection of claims 6-8, see paragraph 7 of the Office Action, the Office Action suggests that the **GroupWis** reference teaches the weight of an entry being dynamically updated “based on the time since an email using matching contact data was sent/received/added to the data store.” The **GroupWise** reference does appear to provide the capability to automatically delete contact entries after a preset time has elapsed without a particular entry being used. However, the Applicants strongly disagree with the suggestion that deleting a contact entry after a predetermined time period in any way corresponds to a “weighting” of contact entries as described and claimed by the Applicants. In fact, it is unclear to the Applicants how eliminating contact entries after a predetermined time could in any way be considered a weighting of those entries, especially since it appears that the **GroupWise** reference would treat a brand new entry exactly the same as an entry that has not been used for nearly six months when the preset time period is set to six months.

With respect to the rejection of claims 9, 16 and 28, the Office Action suggests that the **GroupWise** reference “teaches the weight of an entry dynamically updated as new information enters the data store.” The Office Action offers the capability of the **GroupWise** reference to capture addresses and contact information from new received email messages as evidence of this weighting. However, it is unclear how the capability to capture new contact information in any way teaches or suggests a dynamic weighting of existing entries based on dynamically capturing contact information as it enters a data store as described and claimed by the applicants. Thus, the applicants strongly disagree with the suggestion that capturing new contact information teaches or in any way suggests dynamically updating contact weighting.

Finally, with respect to the rejection of claim 12, the Office Action suggests that the **GroupWise** reference “teaches automatically resolving contact entries by providing the entry having the greatest weight where one entry matches an input...” In fact, from the text cited by the Office Action, it appears that the **GroupWise** reference simply teaches automatically resolving contact entries on an alphabetical completion basis. In view of the preceding discussion, it is clear that the **GroupWis** reference does *not*

assign weights to contact entries, and thus, it is inherently incapable of providing a "closest weighted match." Again, it should be clear that the **GroupWise** provides a closest **alphabetical** match, **not** a closest **weighted** match.

Consequently, the Applicants respectfully suggest that the **GroupWise** alphabetical sort fails to teach the Applicants' weighting of entries as described by claim 4. As the limitations of claim 4 have been incorporated into independent claim 1, the Applicants respectfully suggest that claim 1, as amended, includes elements not taught by the **GroupWise** reference.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 1, has elements not taught in the **GroupWise** reference. Consequently, the rejection of claim 1, as amended, under 35 U.S.C. §102(b) is no longer proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 1-3, 5-10, 12-16, 21-22, and 26-31 under 35 U.S.C. §102(b) in view of the claim language of claim 1 which includes the following novel language:

"An electronic contact resolution method, comprising:  
    automatically extracting contact information from a data store;  
    maintaining a list of at least one contact entry derived from the  
contact information extracted from the data store;  
    **automatically weighting each entry in the list,**  
    tracking contact information associated with the contact entry; and  
    automatically resolving contact entries in real time by dynamically  
providing specific contact entries from the maintained list **based on the  
weight of each entry in the list.**" (emphasis added)

### 3.2 Rejection of Claim 32:

With respect to claim 32, the Office Action rejected independent claim 32 under 35 U.S.C. §102(b) over the **GroupWise** reference based on the same rationale as used for the rejection of claim 1. However, as with claim 1, claim 32 has been amended to include a “weighting” element.

Specifically, claim 32 has been amended to include the limitations of claim 37, so as to recite “a **weight module that dynamically weights each entry** in the dynamic list” (emphasis added). As discussed above with respect to the rejection of claim 1, the **GroupWise** reference fails to teach or suggest a weighting of contact entries.

Consequently, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 1, has elements not taught in the **GroupWise** reference. Consequently, the rejection of claim 32, as amended, under 35 U.S.C. §102(b) is no longer proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 32-36, 39-42, and 45-47 under 35 U.S.C. §102(b) in view of the claim language of claim 32 which includes the following novel language:

“A system for automatically generating a dynamic list of entries containing contact information comprising:

- a data store comprising electronic files;
- a scan module that scans the data store;
- an extract module that extracts contact information from the scanned data;
- a populate module that populates the list with the information extracted from the scanned files; and
- a **weight module that dynamically weights each entry in the dynamic list.**” (emphasis added).

### 3.3 Rejection of Claim 48:

With respect to claim 48, the Office Action rejected independent claim 48 under 35 U.S.C. §102(b) over the **GroupWise** reference based on the same rationale as used for the rejection of claim 1. However, claim 48 has been amended to describe and limit the Applicants "data store."

In particular, claim 48 has been amended to suggest that the "data store" includes not only emails, but also "any of word processor files, spreadsheet files, database files, and presentation files." Support for this limitation is provided in the specification on page 11, in the paragraph provided on lines 18-27. Specifically, this text explains that contact information is automatically extracted from any accessible electronic data file, including emails, word processor files, spreadsheet files, database files, and presentation files.

In contrast, as admitted by the Office Action in paragraph 16, the **GroupWise** reference merely "teaches capturing addresses and contact information from sent and received email messages, created by email clients." Clearly, the **GroupWise** reference fails to teach or suggest a capability for extracting contact information from electronic files other than email messages.

Consequently, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 48, has elements not taught in the **GroupWise** reference. Consequently, the rejection of claim 48, as amended, under 35 U.S.C. §102(b) is no longer proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 48-53 under 35 U.S.C. §102(b) in view of the claim language of claim 48 which includes the following novel language:

"A method for automatically generating a dynamic list of entries containing contact information comprising:

scanning a data store containing electronic files ***including emails and any of word processor files, spreadsheet files, database files, and presentation files***;

extracting contact information from the scanned files; and

populating the list with the information extracted from the scanned files.”

(emphasis added)

#### **4.0 Rejections Under 35 U.S.C. §103(a):**

In the Office Action of October 22, 2002, claims 11, 23, 43, and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ***GroupWise*** reference in view of Goodhand et al. (“***Goodhand***,” U.S. Patent No. 5,923,848).

In order to deem the Applicant’s claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, ***to modify the reference or to combine reference teachings***. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), all of the claimed elements of an Applicant’s invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).



#### 4.1 Rejection of Claim 11:

With respect to claim 11, the Office Action rejected dependent claim 11 under 35 U.S.C. §103(a) based on the rationale that the **GroupWise** reference teaches all the limitations of claim 11 with the exception of providing a most recently used match to an input. The Office Action then offered column 18, lines 36-48 of the **Goodhand** reference as teaching a “most recently used match in the context menu based on an input. However, the text the **Goodhand** reference cited by the Office Action reads:

“If Bill Bailey is the intended recipient, the user need not take any other action before sending the message. However, if the user intended to send the message to someone other than Bill Bailey, the user may override the nickname using a context menu 710 (FIG. 7c). This process is identical to the process for resolving names described in conjunction with FIG. 6b, except that ***the first name listed in the context menu 710 is the name to which the nickname has been matched. If the user overrides the previous nickname, the “billb” name in the nicknames memory cache is redefined to correspond to the most recent intended recipient. Thus, a nickname appears only once in the nickname list and is overwritten as changes or corrections are made by the user.***” (emphasis added)

Clearly, **Goodhand** is **not** describing providing a most recently used match to an input. Instead, it appears that **Goodhand** is actually describing a scenario wherein a “nickname” appears **only once**, and is associated with a particular contact, and wherein the user is given the opportunity to override the nickname association with a particular contact if the intended recipient is not the intended recipient.

In stark contrast, the Applicants describe and claim a system wherein a most recently used contact which at least partially matches the user’s input is given priority over other equally matching contact entries with respect to the Applicants claimed automatic contact resolution. Further, as described above with respect to the rejection

of claim 1, the **GroupWis** reference fails to teach or suggest the Applicants claimed weighting of contact entries.

Thus, the suggested **GroupWise-Goodhand** combination fails to teach at least two elements of the Applicants claimed invention, namely weighting of elements and providing most recently used contact entries.

Therefore, as can be seen from the preceding discussion, the suggested **GroupWise-Goodhand** hybrid scheme proposed by the Office Action fails to teach at least two claimed limitations of the Applicants claimed invention, namely weighting of elements and providing most recently used contact entries. Thus, no prima facie case of obviousness has been established in accordance with the holdings of *In Re Fine*.

Consequently, it can be seen from the preceding discussion that the rejection of claim 11 under 35 U.S.C. §103(a) fails to meet the requirements of M.P.E.P. Section 706.02(j). In particular, the **GroupWise-Goodhand** combination fails to teach all of the elements of the claimed invention. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as noted above, and dependent claim 11 as follows:

“The method of Claim 1 wherein automatically resolving contact entries comprises ***providing a most recently used match to an input.***” (emphasis added)

Therefore, in view of the foregoing amendments and discussion, it is the Applicants' position that rejected claim 11 is not obvious over **GroupWise** in view of **Goodhand**, and as such is patentable under 35 U.S.C. §103(a). Therefore, the Applicants respectfully traverse the rejection of claim 11 under 35 U.S.C. §103(a) over **GroupWise** in view of **Goodhand**. Thus, the applicants respectfully requests reconsideration of the rejection of claim 11 in view of the non-obviousness of this claim.

#### 4.2 Rejection of Claim 23:

With respect to claim 23, the Office Action rejected dependent claim 23 under 35 U.S.C. §103(a) based on the rationale that the **GroupWise** reference teaches all the limitations of claim 23 with the exception of storing the list in random access memory and caching the list in a non-volatile storage medium. The Office Action then offered column 19, lines 26-31 of the **Goodhand** reference as teaching storage of the list in "memory storage devices."

However, as described above with respect to the rejection of claim 1, the **GroupWise** reference fails to teach or suggest the Applicants claimed weighting of contact entries. Therefore, as can be seen from the preceding discussion, the suggested **GroupWise-Goodhand** hybrid scheme proposed by the Office Action fails to teach at least one claimed limitation of the Applicants claimed invention, namely weighting of elements. Thus, no prima facie case of obviousness has been established in accordance with the holdings of *In Re Fine*.

Consequently, it can be seen from the preceding discussion that the rejection of claim 23 under 35 U.S.C. §103(a) fails to meet the requirements of M.P.E.P. Section 706.02(j). In particular, the **GroupWise-Goodhand** combination fails to teach all of the elements of the claimed invention. This lack of a prima facie showing of obviousness means that the rejected claim is patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as noted above.

Therefore, in view of the foregoing amendments and discussion, it is the Applicants' position that rejected claim 23 is not obvious over **GroupWise** in view of **Goodhand**, and as such is patentable under 35 U.S.C. §103(a). Therefore, the Applicants respectfully traverse the rejection of claim 23 under 35 U.S.C. §103(a) over **GroupWise** in view of **Goodhand**. Thus, the applicants respectfully requests reconsideration of the rejection of claim 23 in view of the non-obviousness of this claim.

#### 4.3 Rejection of Claims 43 and 44:

With respect to claims 43 and 44, the Office Action rejected dependent claims 43 and 44 under 35 U.S.C. §103(a) based on the rationale that the **GroupWise** reference teaches all the limitations of claim 43 and 44 with the exception of entries from the list being added to an address book via a user interface. The Office Action then offered column 18, lines 2-6 of the **Goodhand** reference as teaching adding names appearing in the list to an address book.

However, as described above with respect to the rejection of claim 32, the **GroupWise** reference fails to teach or suggest the Applicants claimed weighting of contact entries. Therefore, as can be seen from the preceding discussion, the suggested **GroupWise-Goodhand** hybrid scheme proposed by the Office Action fails to teach at least one claimed limitation of the Applicants claimed invention, namely weighting of elements. Thus, no prima facie case of obviousness has been established in accordance with the holdings of *In Re Fine*.

Consequently, it can be seen from the preceding discussion that the rejection of claims 43 and 44 under 35 U.S.C. §103(a) fails to meet the requirements of M.P.E.P. Section 706.02(j). In particular, the **GroupWise-Goodhand** combination fails to teach all of the elements of the claimed invention. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 32, as noted above.

Therefore, in view of the foregoing amendments and discussion, it is the Applicants' position that rejected claims 43 and 44 are not obvious over **GroupWise** in view of **Goodhand**, and as such are patentable under 35 U.S.C. §103(a). Therefore, the Applicants respectfully traverse the rejection of claims 43 and 44 under 35 U.S.C. §103(a) over **GroupWise** in view of **Goodhand**. Thus, the applicants respectfully

requests reconsideration of the rejection of claims 43 and 44 in view of the non-obviousness of these claims.

### **CONCLUSION**

In view of the above, it is respectfully submitted that claims 1-3, 5-36 and 38-53 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-3, 5-16, 21-23, 26-36 and 39-53, and objection to claims 17-20, 24, 25, and 38, and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,



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